

**REMARKS**

Claim 42 has been amended based on the disclosure at, e.g., page 33, lines 9-13, page 22, last full sentence, and page 24, last full sentence, to further clarify the structure of the photosensitive transfer material and the timing of removal of the alkali-soluble resin layer and interlayer. Claim 43 has been added based on, e.g., the Examples in the present specification.

Entry of the above amendment is respectfully requested.

**Restriction**

On page 2 of the Office Action, in paragraph 2, the Examiner indicates that newly submitted claims 24-41 are directed to an invention that is independent or distinct from the invention originally claimed as follows:

- I. Claims 24-41, drawn to a method, classified in class 430, subclass 127.
- II. Claim 42, drawn to a spacer, classified in class 428, subclass 1.55.

The Examiner indicates that the inventions are distinct because the spacer can be formed by a method which further comprises an extra step of adding a light-sensitizer to the resin composition to enhance the efficiency of the photodevelopment step, and another extra step of adding a heat-sensitizer to the resin composition to enhance the efficiency of the curing step. Further, the Examiner indicates that since applicant has received an action on the merits for the originally presented invention, i.e., the spacer, this invention has been constructively elected by original presentation for prosecution on the merits, so claims 24-41 are withdrawn from consideration as being directed to a non-elected invention.

In response, Applicants note that if the elected product claim is found to be allowable, the non-elected process of making the product should be rejoined with the elected product claim if it contains all the elements of that product claim (see MPEP 821.04). Accordingly, if the non-elected process claims have not been amended to include all the elements of the elected product claim when the elected product claim is in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned so that an amendment can be made to facilitate rejoinder.

**Rejection under 35 U.S.C. 112, Second Paragraph**

On page 3 of the Office Action, in paragraph 6, claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

**The Examiner's Position**

The Examiner's position is that it is unclear (1) if the photosensitive transfer material which comprises the temporary support, alkali-soluble thermoplastic resin layer, interlayer, and the photosensitive resin layer arranged in this order is attached to the receptor upon applying the photosensitive resin layer to the receptor, and (2) whether the step of removing the unexposed portions in the photosensitive resin layer using an alkaline aqueous solution also removes the alkali-soluble thermoplastic resin layer as well, leaving the interlayer still attached to the exposed portions of the photosensitive resin layer.

**Applicants' Response**

In response to this rejection, and to expedite allowance, Applicants have amended claim 42 so as to further clarify the structure of the photosensitive transfer material and the timing of

removal of the alkali-soluble resin layer and interlayer. In this regard, Applicants note that amended claim 42 defines that the alkali-soluble resin layer and interlayer are removed at the time of removing unexposed portions of the photosensitive resin layer. Further, Applicants note that new claim 43 defines that the alkali-soluble resin layer and the interlayer are removed prior to the development of the photosensitive resin layer.

Thus, Applicants submit that the rejection under 35 U.S.C. 112, second paragraph, has been overcome, and withdrawal of this rejection is respectfully requested.

#### **Art Rejection**

On page 4 of the Office Action, in paragraph 7, claim 42 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki (US 6,191,184).

#### **The Examiner's Position**

The Examiner's position appears to be basically that Suzuki teaches a spacer formed from a resin composition for a spacer within the scope of that recited for the present invention, and that while Suzuki fails to teach that the spacer is formed by the method recited in the present invention, the Suzuki spacer itself is the same as that presently claimed, unless Applicants can show otherwise. In this regard, the Examiner notes that for product-by-process claims (such as claim 42), patentability is determined based on the product itself. The Examiner notes that the patentability of a product does not depend on its method of production, and that if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

### **Applicants' Response**

In response to this rejection, Applicants note initially that claim 42 has been amended so as to define that the resin composition also comprises an extender as an essential element, and to define the content thereof. New claim 43 also includes recitations in this regard.

Suzuki et al. discloses a composition which comprises fillers (see Suzuki et al., column 16, lines 41-48), but does not teach or suggest the content range defined in the present invention. Further, Suzuki et al. discloses a liquid type composition for a spacer, whereas the present invention discloses a film type of the photosensitive transfer material comprising the photosensitive resin layer.

Therefore, Applicants submit that there is no motivation in Suzuki et al. to achieve the range of the present invention in view of the film strength or transparency (see the present specification, page 17, lines 8-19).

Accordingly, Applicants submit that the present invention is neither anticipated by nor obvious over Suzuki et al., and withdrawal of this rejection is respectfully requested.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 10/695,906

Attorney Docket No. Q78005

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Bruce E. Kramer  
Registration No. 33,725

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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